

Appl. No. 09/854,181
Amdt. dated April 5, 2004

REMARKS

In the Office Action mailed June 12, 2003, claims 1-10, 24-30, 38-39 and 49-68 were rejected under 35 U.S.C. 112, second paragraph. Claims 11-23, 31-37, 40-48, and 69-70 were withdrawn from consideration. Claims 1, 4-10, 24-30, 38-39, 56-59 and 62-63 were rejected under 35 U.S.C. 103(a).

This submission under 37 C.F.R. 1.114 accompanies a Request for Continued Examination.

The Amendments

Claims 1, 2 and 56 have been amended to specify m is an integer greater than 3 and less than or equal to 10 and n is an integer from 1 to 10. These amendments to claim 1, 2 and 56 are supported by the specification as filed, including page 10, lines 3 and 4. The amendments to "m" and "n" do not require any further searching by the Examiner, since the limitations are present in the elected species Formula 3C on page 21, and have been searched, as shown by the JP references cited which include the "m" and "n" variable ranges used in the present claims. Claims 7, 8, 9, 10, 24, 38, 39, 58 and 59 have been cancelled as duplicative, without prejudice. The dependency of claims 3, 4, 25, 49-54, 60-63 and 66-68 has been changed. Typographical errors have been corrected in claims 3, 25, 56 and 67. Claims 1 and 56 have been amended to specify R¹ contains at least one Si atom. These amendments to claims 1 and 56 are supported by the specification as filed, for example page 11, line 11. Claims 60 and 61 have been amended to clarify the R variable. Claim 2 has been made independent. Claim 57 has been amended to delete the R variable as repetitive. No new matter is added by any amendment, and all amendments are supported by the specification and claims as filed.

Withdrawn Claims

In the Office Action mailed June 12, 2003, claims 11-23, 31-37, 40-48, and 69-70 were withdrawn from consideration as being drawn to a nonelected invention. The Office Action stated there was no allowable generic or linking claim. In view of the arguments and

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amendments presented herein, it is believed claims 1, 2 and 56 are allowable generic claims. Reconsideration and rejoinder of the withdrawn claims is respectfully requested.

Rejections under 35 U.S.C. 112, second paragraph

In the Office Action mailed June 12, 2003, claims 1-10, 24-30, 38-39 and 49-68 were rejected under 35 U.S.C. 112, second paragraph.

The Office Action stated: "In Claims 1 and 56, the notation 'n' is not defined. Also, the notation 'm' should be more clearly defined (i.e., what is upper limit for m)." In response, the claims have been amended as specified above. These amendments are believed to overcome the rejection.

The Office Action stated: "In Claims 7 and 58, the claim is vague because the R group in Claims 1 and 56 (amended on 3/24/2003) is limited to a partially fluorinated ether ($C_nF_{2n+1}C_mH_{2m}$) or partially fluorinated alkyl." In response, claims 7 and 58 have been cancelled as duplicative, without prejudice.

The Office Action stated: "In Claims 8, 24 and 57, the R² is not defined." In response, claim 57 has been amended for clarity. Claims 8 and 24 have been cancelled as duplicative, without prejudice.

The Office Action stated: "In Claims 9-10 and 59, the notation 'm' is outside range of Claim 1, which is greater than 3." In response, claims 9, 10 and 59 have been canceled as duplicative, without prejudice.

The Office Action stated: "Claims 2-6, 25-30, 38-39, 49-55 and 60-68 are rejected because they are depended on the rejected claims." In response, it is believed the rejected claims are allowable. Claim 2 has been made independent. Claims 3-6, 25-30, 49-55 and 63-68 depend from claim 2. Claims 60-62 depend from claim 56.

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Reconsideration and withdrawal of the rejections is respectfully requested.

Rejection under 35 U.S.C. 103(a)

In the Office Action mailed June 12, 2003, claims 1, 4-10, 24-30, 38-39, 56-59 and 62-63 were rejected under 35 U.S.C. 103(a) over JP 8-113784 or JP 8-82778. The Office Action stated: "The references disclose a novel compound represented by formula (I) and liquid crystal composition containing the compound (see formula (I) on page 1 and table 1 on page 4 and the liquid crystal composition is shown on page 6 of JP 113784 and first chemical structure on page 48 and section 0017 on page 57 of JP 82778). The references differ from the claims in that the claims exclude the compounds exemplified in the reference by providing the proviso in the present claims. However, the notations m and n are taught ($m=1-14$ and $n=0-13$) in the references and within the ranges of the present invention. It would have been obvious to those skilled in the art to obtain the present invention by following the guidelines of the references."

Claims 1 and 56 have been amended to specify R^1 contains at least one Si atom. The cited references do not teach or suggest this limitation with the partially fluorinated tail groups specified in claims 1 and 56. These amendments to claims 1 and 56 are supported by the specification as filed, for example, page 11, line 11. It is believed this rejection should only apply to claims 1, 56-57 and 62, since claims 4-6, 25-30, and 63 have been amended to depend from claim 2, and claims 7-10, 24, 38-39, 58 and 59 have been cancelled. Claims 57 and 62 depend from claim 56.

It is believed the above arguments and amendments overcome the rejection.
Reconsideration and withdrawal of the rejection is respectfully requested.

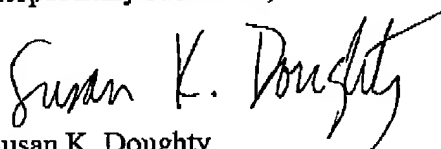
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CONCLUSION

In view of the above, it is believed claims 1-6, 11-23, 25-37, 40-57, 60-70 are allowable. Reconsideration and withdrawal of the rejections is respectfully requested. If there are any issues remaining to passage of the case to issuance, the Examiner is respectfully requested to telephone the undersigned.

Please charge any fee due, including any extensions of time required, to Deposit Account No. 07-1969.

Respectfully submitted,



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